

REMARKS

Claims 1-59 are currently pending. Claim 25 and paragraph 64 have been amended to correct a typographical error. Claims 31-59 have been withdrawn as directed to a non-elected invention. Applicants reserve the right to file divisional applications directed to the non-elected claims.

Applicants note that the Office has indicated in the Office Action Summary that the specification is objected to, but has not stated specifically what the objection is. Applicants therefore respectfully request the Examiner to more specifically set forth what, if any, objections there are to the specification.

1. Objection to the Claims

The Office has objected to claim 25, stating that the term "antiviral" is misspelled. Claim 25 has been amended to change "antivirul" to "antiviral".

2. Rejection of the Claims under 35 U.S.C. §112, first paragraph

Reconsideration is requested of the rejection of claim 24 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In particular, the Office has stated that the specification does not teach how to use glucosylceramide (citing no amounts, weights or percentages given, and no discussion as to how it is incorporated into the tissue product).

MPEP 2163 states that "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." Furthermore, with regard to originally filed claims, it is well accepted that "a satisfactory description may be in the claims or any other portion of the originally filed specification."¹

Applicants note that glucosylceramide is set forth in claim 24 as originally filed. Original claim 24 reads: "The tissue product as set forth in claim 23 wherein the ceramide is glucosylceramide." Written description support for glucosylceramide may therefore be found in original claim 24.

With regard to the Office's comments regarding amounts, weights, percentages, and method for incorporating glucosylceramide into the tissue product, applicants respectfully note that in order to satisfy written description, the claimed invention must be described in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. In the

¹ MPEP §2163. See also *id.*, citing *In re Koller*, 613 F.2d 819 (CCPA 1980) (original claims constitute their own description); MPEP 2163.06 ("The claims as filed in the original specification are part of the disclosure."); MPEP §608.01(l) ("In establishing a disclosure, applicant may rely not only on the description and drawings as filed but also on the original claims if their content justifies it. Where subject matter not shown in the drawings or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.").

present case, possession is clearly shown by the disclosure of glucosylceramide in original claim 24. Applicants are not required to show how to make or use tissues comprising glucosylceramide to satisfy the written description requirement.

3. Rejection of the Claims under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 1-23 and 25-30 under 35 U.S.C. §103(a) as being unpatentable over McAtee, et al. (U.S. Patent No. 5,607,980).

Claim 1 is directed to a tissue product comprising a tissue paper and a moisturizing and lubrication composition. The moisturizing and lubricating composition comprises from about 1% (by weight) to about 40% (by weight) of an emollient, from about 1% (by weight) to about 20% (by weight) of a humectant, from about 30% (by weight) to about 90% (by weight) an immobilizing agent, and from about 1% (by weight) to about 40% (by weight) of a compatibilizing agent wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.

McAtee, et al. disclose compositions for conditioning, desquamating, and cleansing the skin, and for relieving dry skin. The compositions comprise from about 0.1% to about 20% by weight of an amphoteric surfactant, from about 0.1% to about 20% by weight of an anionic surfactant, from about 0.1% to about 15% by weight of a cationic surfactant, and from about 45% to

about 99.7% by weight water. Significantly, McAtee, et al. fail to disclose a moisturizing and lubricating composition wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2143 requires that the Office must meet three criteria: (1) the prior art reference must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under number (1) and/or (2) above, as the cited reference does not teach or suggest all of the claimed limitations and there is no motivation or suggestion to modify the reference to arrive at each and every limitation of Applicants' claim 1.

Initially applicants note that contrary to the Office's assertion, McAtee, et al. fail to teach or suggest a tissue product comprising a moisturizing and lubricating composition. The Office has stated that McAtee, et al. teach a tissue product, and cites column 4, line 16 of McAtee, et al. in support of this assertion. While McAtee, et al. describe compositions that may be formulated into creams, lotions,

mousses, sprays, rinse-off cleansers, water-less cleansers, bars, gels, etc., they say nothing about tissue products comprising moisturizing and lubricating compositions. The passage referred to by the Office merely states that the "water-less" compositions can be "removed by wiping with a device such as a cotton ball, a cotton pad, a tissue, a towel, and the like,"² but does not disclose a tissue product as set forth in applicants' claim 1.

Additionally, as noted above, McAtee, et al. fail to teach or suggest a moisturizing and lubricating composition wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C. These are significant aspects of applicants' invention.

As noted in the specification of the present application, liquid components of the moisturizing and lubricating compositions are important in that they provide plasticity and help avoid products that are too hard, brittle, or flaky. However, compositions that contain a high proportion of components that are liquid at room temperature are more difficult to process. Furthermore, if the composition contains too high a proportion of liquid components, the liquid components of the composition may migrate away from the surface of the substrate to which the composition is applied, and into

² See McAtee, et al. at col. 4, lines 14-16 (emphasis added).

the matrix of the fabric of the substrate. It is thus important that the compositions comprise a certain percentage of components that are solid at room temperature. In particular, the solid components, such as the immobilizing agents, provide a network that is capable of supporting the liquid components within it and, therefore, preventing their migration through the substrate. If the solid portion of the composition is too small, the network may be overwhelmed by the large liquid portion, and the solids portion may be unable to support the liquids in the network. See Specification at ¶55. To address this problem, the compositions of the present invention comprise no more than about 50% (by weight) of components that are liquid at room temperature and no less than about 50% of components that are solid at room temperature.

There is simply nothing in McAtee, et al. stating that the compositions disclosed therein should comprise no more than about 50% (by weight) of components that are liquid at room temperature and no less than about 50% of components that are solid at room temperature and no recognition of the advantages of such a composition. Nor is there any motivation in McAtee, et al. to modify the compositions described therein to arrive at a moisturizing and lubricating composition wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature. In fact, if anything, McAtee, et al. teach away from such compositions.

As noted above, the compositions of McAtee, et al. comprise from about 45% to about 99.7% water, preferably comprise from

about 60% to about 95%, and most preferably comprise from about 70% to about 90% water.³ Furthermore, the specific examples of the compositions set forth in the Examples of McAtee, et al. all comprise more than 80 wt.% water. As will be apparent to those skilled in the art, water is liquid at room temperature. Thus, the preferred embodiments, and all of the specific examples of compositions set forth in McAtee, et al. have significantly higher percentages of components that are liquid at room temperature than the compositions set forth in applicants' claim 1. Based on this disclosure, one skilled in the art would in fact be motivated by McAtee, et al. to prepare compositions that comprised more than 50% by weight of components that are liquid at room temperature, in direct opposition to the compositions set forth in applicants' claim 1.

Furthermore, applicants note that there would be no reason, based on the disclosure in McAtee, et al., to modify the compositions described therein so that no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature. As noted above, the compositions of McAtee, et al. may be formulated into creams, lotions, rinse-off or water-less cleansers, and the like, but are not described for use on a tissue product. In contrast, the claims of the present invention are directed to tissue products comprising a tissue paper and a moisturizing and lubrication composition. As noted above, if a composition contains too high a proportion of liquid components, the liquid components of the composition may migrate

³ See McAtee, et al. at col. 9, lines 34-37.

KCC 4979.2
(K-C 19,378C)
PATENT

away from the surface of the substrate to which the composition is applied, and into the matrix of the fabric of the substrate. To address this problem, the compositions of the present invention comprise no more than about 50% (by weight) of components that are liquid at room temperature and no less than about 50% of components that are solid at room temperature. This, however, is not a concern for McAtee, et al. since, as noted above, the compositions described therein are not described as for use on a tissue product. Consequently, there would be no reason for one skilled in the art to modify the compositions of McAtee, et al. so that the compositions comprise no more than about 50% (by weight) of components that are liquid at room temperature and no less than about 50% of components that are solid at room temperature.

Along these lines, applicants note that McAtee, et al. also fail to teach or suggest a composition comprising from about 30% (by weight) to about 90% (by weight) of an immobilizing agent. The Office has cited to column 16, lines 59-64 of McAtee, et al. as teaching immobilizing agents. However, this cited passage merely lists various polyethylene glycols that may be included as non-ionic surfactants in the compositions of McAtee, et al.⁴ The listed PEGs are not, however, immobilizing agents. As noted in paragraph 50 of the specification, immobilizing agents may include high molecular weight (greater than about 720) polyethylene glycols that are solids at room temperature. The

⁴ The listed surfactants include PEG-2 stearate, PEG-4 stearate, PEG-6 stearate, PEG-10 stearate, PEG-12 stearate, PEG-20 glyceryl stearate, PEG-80 glyceryl tallowate, PPG-10 glyceryl stearate, PEG-30 glyceryl cocoate, PEG-80

PEGs listed in the passage cited by the Examiner all appear to be low molecular weight PEGs, and thus not suitable immobilizing agents.

The Office has also cited column 16, line 13 of McAtee, et al. as disclosing fatty alcohol immobilizing agents. Applicants respectfully submit that the Office appears to be misinterpreting this passage of McAtee, et al. The cited portion of McAtee, et al. is merely giving examples of long chain alcohols which may be used to form a condensation product with sugar or starch polymers. It is the condensation product that may be included in the composition of McAtee, et al. as a non-ionic surfactant. McAtee, et al. do not state that the listed long chain alcohols themselves are included in the composition. McAtee, et al. thus fail to teach or suggest a composition comprising from about 30% (by weight) to about 90% (by weight) an immobilizing agent.

Nor is there any motivation to modify the compositions of McAtee, et al. to include immobilizing agents in the claimed percentages. The Office has stated that McAtee, et al. do not explicitly teach all the percentages recited in the claims, but it would have been obvious to determine suitable percentages through routine experimentation. Applicants respectfully disagree.

As noted above, the solid components, such as the immobilizing agents, in the compositions of the present invention provide a network that is capable of supporting the

glyceryl cocoate, PEG-200 glyceryl tallowate, PEG-8 dilaurate, PEG-10 distearate, and mixtures thereof.

liquid components within it and, therefore, preventing their migration through the substrate. McAtee, et al., however, are not concerned with preventing migration of their composition through a substrate since, as discussed above, their compositions are not used in connection with a tissue paper substrate. There is simply nothing in McAtee, et al. that would motivate one skilled in the art to include an immobilizing agent in the compositions described therein in the claimed amounts. Claim 1 is thus patentable over McAtee, et al. for this additional reason.

Additionally, it is well settled that the burden is on the Office to provide some suggestion of the desirability to do what the inventor has done; that is, the Office must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teachings of the references. Applicants respectfully submit that the Office has not presented a convincing line of reasoning as to why one skilled in the art would be motivated to modify McAtee, et al. to produce at a composition comprising an emollient, a humectant, a compatibilizing agent, and an immobilizing agent in the claimed amounts, wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C, as required by the MPEP.⁵

⁵ MPEP §2142 states:

The Office has merely stated that it would be obvious to one skilled in the art to combine an emollient, a humectant, an immobilizing agent, and a compatibilizing agent into a tissue product for the beneficial effects of conditioning the skin, desquamating the skin, cleansing and clarifying the skin, reducing skin pore size, and relieving dry skin, as explained by McAtee, et al. The Office does not, however, present any reasoning as to why one skilled in the art would modify the McAtee, et al. compositions to comprise from about 30% (by weight) to about 90% (by weight) an immobilizing agent, or why one skilled in the art would modify the compositions of McAtee, et al. so that no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.⁶ Claim 1 is thus patentable for this additional reason.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added).

⁶ The Office has stated that while McAtee, et al. does not disclose phase temperatures, melting point, and penetration hardness, "Applicant's article is the same as the prior art. It contains the same components in the same configuration," and that properties are the same when the structure and composition are the same. Applicants respectfully note that the Office has in fact admitted that the compositions of McAtee, et al. are not in fact the

Claims 2-23 and 25-30 depend directly or indirectly from claim 1 and are thus patentable for the same reasons as set forth above for claim 1 as well as for the additional elements they require.

4. Double Patenting Rejections

Claims 1-30 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of copending Application No. 10/659,969.

Applicants note this rejection is in fact a provisional obviousness-type double patenting rejection since U.S. Patent Application No. 10/659,969 has not yet issued as a patent. Applicants will address the merits of these rejections, as appropriate, if the listed application issues as a patent before the application at hand.

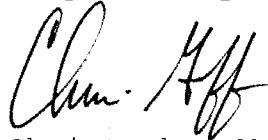
same as those set forth in the present claims, stating on page 4 of the Office action that "McAtee, et al. do not explicitly teach all the percentages recited in instant claims 1, 4, 8, 15, 18, and 21." Furthermore, for the reasons set forth above, the compositions of McAtee, et al. differ in significant aspects from those set forth in applicants claims and therefore cannot be said to inherently have the same properties as set forth in applicants' claims. These statements by the Office thus do not constitute a convincing line of reasoning.

KCC 4979.2
(K-C 19, 378C)
PATENT

CONCLUSION

In light of the foregoing, applicants request withdrawal of the rejections of claims 1-30 and allowance of all pending claims. The Commissioner is hereby authorized to charge any government fees which may be required to Deposit Account No. 19-1345.

Respectfully Submitted,



Christopher M. Goff, Reg. No. 41,785
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
314-231-5400

CMG/LJH/cms
By EFS